

REMARKS/ARGUMENTS

The Office Action mailed June 25, 2009, has been received and reviewed. Claims 1-21 are currently pending in the application. Claims 1-21 stand rejected. Applicant has amended independent claims 1, 13, 14, 17, 20 and 21, and respectfully requests reconsideration of the application as amended herein. Support for Applicant's amendments is found in at least Applicant's as-filed specification at paragraphs [1005], [1019] and [1041]. No new matter has been added.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on Amerga in view of Bamburak

Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. US 2003/0231605 to Amerga ("Amerga") in view of U.S. Patent Publication No. US 2004/0219915 to Bamburak *et al.* ("Bamburak").

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be "a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant's disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-21 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art references must teach or suggest all the claims limitations.

The Office Action, in attempting to support a teaching or Applicant's claim element of a "*transceiving gap*," asserts:

Bamburak discloses that when downloading the search schedule in step 80, **frequency bands** previously searched **are removed from the downloaded schedule** (*read as gap*) so as to avoid searching bands that have already been searched. Office Action, p. 2; italics emphasis in original; bold emphasis added).

Applicant has amended independent claims 1, 13, 14, 17, 20 and 21 to more clearly recite Applicant's claimed element of the "transceiving gap" as being *time*-based (*i.e.*, "duration") rather than the Office Action's applied interpretation of the "transceiving gap" as being *frequency*-based (*i.e.*, "frequency bands ... are removed from the downloaded schedule"). Applicant's amended independent claims 1, 13, 14, 17, 20 and 21 each recite, in part, "a serving cell ***transceiving gap defined as a duration*** for searching outside of a serving cell" which is not taught in Amerga or Bamburak. Applicant respectfully notes that Bamburak is void of any teaching of a "***transceiving gap defined as a duration***" as supported in Applicant's specification which recites, in part,

[1005] ... gaps in transmission and reception on a serving frequency

[1019] ... gaps are introduced during which reception and transmission are stopped so that the mobile station may switch frequencies or radio access technologies to make measurements, without losing data transmission from or to the serving cell.

[1041] ...when a gap is scheduled, how long the gap will be, when the next gap-free period of a certain length may occur

Therefore, since neither Amerga nor Bamburak teach or suggest Applicant's claimed invention including "a serving cell ***transceiving gap defined as a duration*** for searching outside of a serving cell", these references, either individually or in any proper combination, **cannot** render obvious, under 35 U.S.C. §103, Applicant's invention as presently claimed in amended independent claims 1, 13, 14, 17, 20 and 21. Accordingly, Applicant respectfully requests the rejection of amended independent claims 1, 13, 14, 17, 20 and 21 be withdrawn.

The nonobviousness of independent claim 1 precludes a rejection of claims 2-12 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 1 and claims 2-12 which depend therefrom.

The nonobviousness of independent claim 14 precludes a rejection of claims 15 and 16 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see

also MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 14 and claims 15 and 16 which depend therefrom.

The nonobviousness of independent claim 17 precludes a rejection of claims 18 and 19 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 17 and claims 18 and 19 which depend therefrom.

CONCLUSION

In light of the amendments contained herein, Applicant submits that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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